

### **REMARKS**

Claims 7-12, 14, and 26-43 were previously pending, with Claims 26-43 under examination. Claims 27 and 32-43 have been cancelled, Claims 26 and 29-31 have been amended, and Claims 44-52 have been added as discussed herein.

Support for the amendments can be found throughout the specification and claims as filed. More particularly, support can be found, *e.g.*, in Example 1. No new matter has been added by the amendments. Applicants submit that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

#### **Rejection under 35 U.S.C. § 112, First Paragraph – Enablement**

Claims 26-32 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide enablement for the full scope of the claims. The Examiner argues that the specification “teaches only the CaSKO mouse lacking Shp2 in CaMK2a expressing cells,” and therefore “fails to enable any mouse other than a genetically modified mouse whose genome comprises a Shp2<sup>fllox</sup> allele wherein the Shp2 gene is functionally disrupted in CaMK2a-expressing cells such that no Shp2 is expressed in said cells....” *Office Action* at pp. 3-4. The Examiner further asserts that “[t]he CaMK2a promoter drives expression only in the neurons of the hippocampus (see Reece 2004, page 388, provided herewith).” *Id.* at p. 3.

Without acquiescing to the Examiner’s objections, and solely in the interest of advancing prosecution, Applicants have amended independent Claim 26 to recite a genetically modified mouse “whose genome comprises a homozygous disruption of the endogenous Shp2 gene in at least a portion of forebrain cells such that no Shp2 is expressed in said portion of forebrain cells.” Applicants submit that the specification provides enablement for the full scope of amended Claim 26. Further, Applicants submit that one of ordinary skill in the art at the time of filing would have known that the CaMK2a promoter does not “drive[] expression only in the neurons of the hippocampus” (and note that the reference cited by the Examiner was not provided with the Office Action dated August 19, 2010). Applicants therefore respectfully request that the Examiner withdraw the rejection of Claim 26 and claims dependent therefrom (*i.e.*, Claims 28-31) under 35 U.S.C. § 112, first paragraph.

**Rejection under 35 U.S.C. §112, First Paragraph – Enablement**

Claims 33-43 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner argues that the specification “does not discuss use of Shp2- disrupted mice in a screen as claimed.” *Office Action* at p. 5.

Without acquiescing to the Examiner’s objections, and solely in the interest of advancing prosecution, Applicants have cancelled Claims 33-43. Applicants submit that the rejection is therefore moot and respectfully request that the Examiner withdraw the rejection of Claims 33-43 under 35 U.S.C. § 112, first paragraph.

**Rejection under 35 U.S.C. §112, First Paragraph – Written Description**

Claims 33-43 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner argues that the specification “fails to disclose use of the claimed conditional Shp2 disrupted mouse in an in vivo screen.” *Office Action* at p. 6.

Without acquiescing to the Examiner’s objections, and solely in the interest of advancing prosecution, Applicants have cancelled Claims 33-43. Applicants submit that the rejection is therefore moot and respectfully request that the Examiner withdraw the rejection of Claims 33-43 under 35 U.S.C. § 112, first paragraph.

**Rejection under 35 U.S.C. §112, Second Paragraph – Indefiniteness**

Claims 36 and 37 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner argues that the claims are not clear “because if the mouse lacks Shp2 expression the test compound cannot be acting by decreasing Shp2 expression.” *Office Action* at p. 7.

Without acquiescing to the Examiner’s objections, and solely in the interest of advancing prosecution, Applicants have cancelled Claims 36 and 37. Applicants submit that the rejection is therefore moot and respectfully request that the Examiner withdraw the rejection of Claims 36 and 37 under 35 U.S.C. § 112, second paragraph.

**Application No.:** 10/594,170  
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No Disclaimers or Disavowals


Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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AMEND

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